

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Oleg Fedorkin, *et al.*  
Patent No. : 7,491,509  
Issue Date : February 17, 2009  
Serial No. : 10/770,600  
Filed : February 3, 2004  
Title : SYSTEM FOR EXPRESSION OF GENES IN PLANTS

Art Unit : 1636  
Examiner : James S. Ketter

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)**

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 358 to **360 days** is respectfully requested. The error in the Office's calculation of the Patent Term Adjustment arises in part due to the Office's delay in issuing the patent beyond three years from filing. Since the length of this delay could not be determined prior to issuance, the error could not have been raised in an application under 37 C.F.R. § 1.705(b) and therefore the present petition is timely with respect to that issue.

**REMARKS**

"A Delays" are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in *Wyeth v. Dudas*, 580 F. Supp. 2d 138 (D.D.C. 2008), the only way that these periods of time can "overlap" is if they occur on the same day. If an "A delay" occurs on one calendar day and a "B delay" occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. *Id.*

**CERTIFICATE OF MAILING BY EFS-WEB FILING**

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: April 16, 2009

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The *Wyeth v. Dudas* court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.” “B delay” begins only after the PTO has failed to issue a patent within three years, not before. *Id.*

## REVIEW OF THE PATENT TERM ADJUSTMENT CALCULATION

### 1. Patent Office Delay

#### (a) “A Delay”

A first PTO action was due on or before April 3, 2005 (the date that is fourteen months after February 3, 2004, the date on which the application was filed). The PTO mailed the first non-final Office Action on July 15, 2005, thereby according a PTO Delay of 103 days. Patentee does not dispute the PTO's calculation for this “A Delay” from April 4, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to July 15, 2005. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

Patent issuance was due on or before June 29, 2008 (the date that is four months after February 29, 2008, the date on which the issue fee was paid). The PTO issued a patent on February 17, 2009, thereby according a PTO Delay of 233 days. Patentee does not dispute the PTO's calculation for this “A Delay” from June 30, 2008 (the day after the date that is four months after the date on which the issue fee was paid), to February 17, 2009. See 37 C.F.R. §§ 1.702(a)(4) and 1.703(a)(6).

In view of the periods of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 336 days (i.e., the sum of 103 days and 233 days).

**(b) "B Delay"**

The period beginning on February 4, 2007 (the day after the date that is three years after the date on which the application was filed), and ending February 17, 2009 (the date the patent was issued), is 745 days in length.

"B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on September 4, 2007, and the patent issued on February 17, 2009, resulting in a period of 532 days that must also be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

"B Delay" for this patent is therefore calculated as 745 days minus 532 days, for a total of 213 days. The PTO calculated only 110 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 213 days.

**(c) Non-Overlap of "A Delay" and "B Delay"**

As detailed above, "A Delay" accumulated during the following period:

April 4, 2005, to July 15, 2005; and  
June 30, 2008, to February 17, 2009.

As detailed above, "B Delay" accumulated during the following period:

February 4, 2007, to September 4, 2007.

As such, the periods of "A Delay" and "B Delay" do not overlap (i.e., occur on the same calendar day).

## 2. Applicant Delay

A reply to a Notice to File Missing Parts was due on or before August 12, 2004 (the date that is three months after May 12, 2004, the date on which the Notice to File Missing Parts was mailed). Patentee filed a response to the Notice to File Missing Parts that was received by the Office on September 2, 2004, as shown on the date-stamped electronic copy in the PAIR Image File Wrapper, but which was incorrectly entered into PAIR as having been received on August 31, 2004. An Applicant Delay of 19 days was thus accorded; however, the Patentee submits this may be incorrect because it appears the late reply to the Notice to File Missing Parts should have been accorded a total Applicant Delay of 21 days for delay from August 13, 2004 to September 2, 2004. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before October 15, 2005 (the date that is three months after July 15, 2005, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on December 19, 2005, thereby according an Applicant Delay of 65 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from October 16, 2005 (the day after the date that is three months after the date on which the Office Action was mailed), to December 19, 2005. See 37 C.F.R. § 1.704(b).

Patentee filed an Information Disclosure Statement on December 23, 2005, subsequent to a reply filed on December 19, 2005. Patentee was accorded a delay of 4 days for a supplemental response. Patentee does not dispute the PTO's calculation for this Applicant Delay from December 20, 2005, to December 23, 2005. See 37 C.F.R. § 1.704(c)(8).

A reply to an Office Action was due on or before December 11, 2006 (the date that is three months after September 11, 2006, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on March 16, 2007. An Applicant Delay of 0 days was thus accorded; however, in good faith and candor, Patentee respectfully submits that the late reply to the Office Action should have been accorded a total Applicant Delay of 95 days for delay from December 12, 2006 to March 16, 2007. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before August 31, 2007 (the date that is three months after May 31, 2007, the date on which the Office Action was mailed). Patentee filed a

response to the Office Action on September 4, 2007, as shown on the date-stamped electronic copy in the PAIR Image File Wrapper. An Applicant Delay of 0 days was thus accorded; however Patentee respectfully submits this may be incorrect because it appears that the late reply to the Office Action should have been accorded a total Applicant Delay of 4 days for delay from August 31, 2007 to September 4, 2007. See 37 C.F.R. § 1.704(b).

In view of the periods of Applicant Delay detailed above, the Patentee would calculate the total Applicant Delay for this patent as 189 days (i.e., the sum of 21 days, 65 days, 4 days, 95 days, and 4 days).

### **3. Terminal Disclaimer**

This patent is not subject to a terminal disclaimer.

### **4. PTA Calculation and Conclusion**

In consideration of the events described above, Patentee believes the PTA calculation of 358 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 549 days (i.e., the sum of 336 days of "A Delay" and 213 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 189 days; and
- 3) **Total PTA should be calculated as 360 days.**

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Attorney's Docket No.: 24990-0005001 / 2002645-0012 0021

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 24990-0005001.

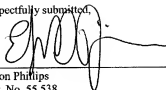
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4/16/2009

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Respectfully submitted,



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